

### **Remarks**

Claims 1-3, 6-25, 27-32, 35-53 and 55-57 are now pending in this application. In this amendment claims 1, 13, 14, 24, 27, 30, 41, 42, 52 and 55 have been amended and claims 4, 5, 26, 33, 34 and 54 have been cancelled.

### **Double Patenting**

In the office action dated July 25, 2008 the Examiner provisionally rejected claims 1-57 on the grounds of double patenting over copending U.S. Patent application Serial No.:10/737,244. As suggested by the Examiner a terminal disclaimer is filed herewith. Accordingly, the rejection may be withdrawn.

### **Claim Rejections Under 35 U.S.C. § 101**

The Examiner rejected claims 24, 25, 27-29, 52, 53, and 55-57 under 35 U.S.C. § 101 because the claimed invention are allegedly directed to a non-statutory subject matter.

First the Examiner asserts that claim 24 is a computer program. This is incorrect. Claim 24 is directed to a "message processing system." The system includes modules that are further "programmed" to take certain actions based on certain criteria. Thus, claim 24 is not a claim for the software standing alone by itself. Rather, it is a system that uses software to operate a certain way. Such systems are regularly the subject of patents.

With regard to claim 52, the Examiner has stated an incorrect test under § 101. The Examiner asserts that a process is not patentable subject matter unless it is "tied to another statutory class" or "transforms underlying subject matter." This rule is not supported by § 101, or by the cases cited by the Examiner. Rather, § 101 specifically provides that processes are patentable subject matter.

It is abstract ideas, laws of nature, or mathematical algorithms that are not patentable. The rejected claim is none of those things. The claim recites specific steps for creating consolidated message packages from a plurality of messages, based on

specific criteria. To the extent that the Examiner feels that the recited steps are inadequate to overcome the prior art, then the those concerns should be addressed under anticipation or obviousness in connection with § 102 or § 103.

**Claim Rejections Under 35 U.S.C. § 112**

The Examiner rejected claims 5,13,14, 34, 41 and 42 under 35 U.S.C. § 112 second paragraph, on the grounds that the specification does not conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regards as the invention. The Examiner objected to the phrase "may, or may not." Applicants have redrafted the claims to avoid that terminology without changing the scope of the claims. Accordingly, the rejection is moot and may be withdrawn.

**Claim Rejections Under 35 U.S.C. § 102**

The Examiner rejected claims 1-4, 9-12, 15-17, 30, 38-40 and 43-45 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,058,030 to Schumacher ("Schumacher"). Independent claim 1 has been amended to incorporate the features of former claim 5. Independent claim 30 has been amended to incorporate features of former claim 34. Thus, the rejection of these claims will be addressed in the respective sections below relating to obviousness under § 103.

**Claim Rejections Under 35 U.S.C. § 103**

*Rejections Over Schumacher in view of Savage*

The Examiner rejected claims 5,13,14, 34, 41 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of U.S. Patent 7,236,950 to Savage, et al. ("Savage"). The subject matter of claim 5 has now been added to independent claim 1. The subject matter of claim 34 has now been added to independent claim 30. Accordingly, the rejections of those Independent claims will be addressed in this section.

In connection with the subject matter of claim 5 (now in claim 1), the Examiner stated that Schumacher does not include a system "wherein the marketing rules include

a rule whether messages that include particular marketing content may be consolidated." The Examiner then relies upon the Savage reference for the proposition that consolidation provides cost advantages. However, Savage fails to disclose, or to suggest, the very thing that the Examiner admits is missing from Schumacher. There is no disclosure in either asserted reference about rules for whether particular marketing content may be consolidated. Savage's general teaching of consolidation does not cure the deficiency of Schumacher. It is impermissible for the Examiner to simply state that it would have been obvious to create elements that are otherwise not found in the prior art. For a prima facie case of obviousness, every element must be found in the prior art. No such showing has been made, and only unsupported assertions have been made. Accordingly, for at least these reasons, the rejection of claim 1 and its dependent claims 13 and 14 should be withdrawn.

Similarly claim 30 recites a step of "preventing messages from being consolidated based on the marketing rules that include a rule whether messages that include particular marketing content may be consolidated" (previously recited in claim 34). Once again Savage fails to cure the deficiency of Schumacher. Accordingly, for at least these reasons, the rejections of claims 30 and dependent claims 41 and 42 should be withdrawn.

*Rejections over Schumacher in view of Johnson*

Claims 6-8 and 35-37 were rejected over Schumacher in view of U.S. Publication No. 2004/0230523 to Johnson ("Johnson"). Claims 6-8 depend from claim 1. Claims 35-37 depend from claim 30. Johnson fails to cure the deficiencies identified above with regard to the Schumacher reference in view of the independent claims. Accordingly, these claims should be allowable for the same reasons.

Further, Johnson fails to disclose or suggest the features of claims 6-8 and 35-37 for which it was asserted. As described by the Examiner, Johnson teaches that a customer can choose whether to receive a hardcopy document, as opposed to an electronic version. However, Johnson does not teach using customer preferences to determine whether consolidation (claims 7, 36) or householding (claims 8, 37) is desired

in the first place. A prima facie case of obviousness has not been made for these claims. Accordingly, the rejections of these claims should be withdrawn.

*Rejections over Schumacher in view of Stepno*

Claims 18-20, 22, 24-26, 28, 46-48, 50, 52 -54 and 56 were rejected over Schumacher in view of U.S. Publication No. 2002/0133472 to Stepno ("Stepno"). Claims 18-20, 22, 24-26, 28, 46-48 and 50 all depend from independent claims discussed above with regard to the Schumacher reference. Since Stepno fails to cure the deficiencies of Schumacher with regard to independent claims 1, 24, and 30, the corresponding dependent claims should be allowable for the same reasons.

With regard to independent claim 52, the subject matter of claim 54 has now been added to that independent claim. Neither Schumacher or Stepno discloses or suggests that "the step of consolidating includes determining whether a customer preference authorizes consolidation for a particular message." The Examiner's unsupported assertion of obviousness is insufficient to support a prima facie case of obviousness.

*Rejections over Schumacher in view of Stepno and Johnson*

Claims 21, 23, 27, 29 49, 51 55 and 57 were rejected over Schumacher in view of Stepno and further in view of Johnson. As described above, the Schumacher, Stepno and Johnson references fail disclose or suggest certain features recited in the independent claims 1, 24, 30, and 52. In making these rejections the Examiner relies on Johnson for teaching generating content in the message describing the benefits of consolidation or householding. However, as admitted by the Examiner, Johnson only describes offering discounts for making quick payments. This disclosure of Johnson is different that what is recited in the claims, so it is inadequate to serve as a teaching or disclosure of the element for purposes of making a prima facie obviousness rejection. Accordingly, the rejections of these claims should be withdrawn.

*Rejecitons over Schumacher alone*

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Claims 31 - 33 were rejected over Schumacher. As discussed above, Schumacher fails to disclose or suggest the features recited in independent claim 30. Accordingly, these dependent claims should be allowable for the same reasons.

**Conclusion**

All rejections having been addressed, it is submitted that this application is in condition for allowance and favorable action is requested. If there are any questions please contact the undersigned attorney.

Respectfully submitted,



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